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Dated: February 1, 2007

Signature:

(James J. Napoli)

Docket No.: 29827/40333
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Samantha Champ et al.

Application No.: 10/502,212

Confirmation No.: 1830

Filed: July 20, 2004

Art Unit: 1711

For: Foams Made from Water-Absorbing, Basic
Polymers, Method for the Production and
Utilization Thereof

Examiner: John M. Cooney

RESPONSE TO RESTRICTION REQUIREMENT

MS Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In response to the Office Action dated January 12, 2007, applicants are required to elect one of the following groups of claims:

Group (I), claims 1-17, directed to products and methods of making the products; or

Group (II), claims 18-21, directed to methods of using the product.

Applicants also are required to elect a species of basic polymers recited in the claims.

Applicants hereby elect the claims of examiner's Group I, namely, claims 1 through 17, inclusive, with traverse, for examination on the merits at this time. Applicants also elect, with traverse, basic polymers containing vinylamine units as the elected species. Claims readable as the elected species are claims 1-21.

It is submitted, however, that all claims 1 through 21, and all species, should be examined at this time. According to PCT Rule 13, claims of different categories with common special technical features do *not* lack unity. Also, see Example 1 in PCT Gazette, page 52, Part 2 I. (copy enclosed).

In the present invention, the common special technical feature in *all* claims is a foam comprising a water-absorbing basic resin, wherein the basic resin contains a nitrogen atom, and is prepared as set forth in claim 1. There may be a lack of unity only if this common technical feature lacks novelty or is obvious. See PCT Gazette page 49, part 1(a) (copy enclosed). Although the examiner alleges that this technical feature lacks patentability over Brueggemann et al. U.S. Patent No. 6,033,769 ('769), the examiner has not articulated why the present claims lack novelty or are obvious over the cited reference. With respect to the election of species, each monomer is a known in the art in the production of basic water-absorbing polymers, and each species contains a nitrogen atom as the basic center. In addition, the *layer* structure of the '769 patent is substantially different from the foam recited in the present claims. For example, compare claim 1 to the '769 patent at column 3, lines 33-53.

Unity of invention in the present application is evidenced further by the International Search Report. In particular, *all* claims were searched. Please note that the claims in the PCT application and in the present application differ in form only, i.e., the searched PCT claims were amended to conform to U.S. practice. The standards regarding unity of invention that apply to the International Searching Authority also apply to the U.S. Patent Office with respect to this application. Therefore, the unity of invention requirement is fulfilled, and any reliance upon independence or distinctness of the invention is not relevant under the PCT.

In addition, M.P.E.P. §1893.03(d) provides that when making a lack of unity of invention requirement, the examiner *must* "explain why each group lacks unity with each other group (i.e., why there is no single general inventive concept) specifically describing the unique special technical feature in each group." A group of inventions is considered linked as to form a single general inventive concept when a technical relationship exists among the inventions that involves at least one common or corresponding special technical feature, i.e., a foam prepared from a water-absorbing basic polymer. That common special technical feature is present in *all* of claims 1-21.

The examiner has not provided proper reasons why each group lacks unity with each other group specifically describing the unique special technical feature in each group as required in M.P.E.P. §1893.03(d). The examiner has considered the type of claims, e.g., product, method of manufacturing, and method of use, without considering the special technical features recited in, and common to, each claim, as set forth above. Furthermore, it must be noted that the claims of examiner's Groups II, claims 18-21, *depend* from claim 1 and therefore *must* share a common technical feature with the claims of examiner's Group I.

The Office Action fails to indicate whether Groups I and II are classified in different classes or subclasses, but, even if differently classified, the inventions are not independent for the reasons set forth above *and* because the products and methods of making set forth in claims 1-17, and the methods of use set forth in claims 18-21, are so closely related that a search for applicants' product claims would necessarily encompass a search for applicants' method of use claims.

Therefore, even if unity of invention arguably is lacking, no evidence exists that a search and examination directed to all claims, and all species, would be a *serious burden* on the examiner, as is required by M.P.E.P. §803. ("If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions." and "There must be a serious burden on the examiner if restriction is not required.")

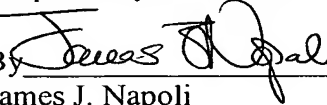
Because search and examination of the entire application can be made without serious burden on the examiner, it would be wasteful of the time, effort, and resources of both the applicants and the Patent Office to prosecute the product and method of use claims in separate applications. Search and examination of all groups of claims, and all species, in a single application would be much more efficient than requiring the Patent Office to prosecute the product method of use claims in separate applications. Search and examination of all groups of claims, and all species, in a single application would be much more efficient than requiring the Patent Office and applicants to do so in separate applications. Accordingly, it is submitted that all claims should be examined at this time.

Reconsideration and withdrawal of the restriction requirement are respectfully requested. An early action of the merits on all claims is solicited.

Should the restriction requirement be deemed final, applicants reserve the right to pursue non-elected claims and species in one or more divisional applications.

Dated: February 1, 2007

Respectfully submitted,

By 

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